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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,231	03/09/2004	Marc Husemann	tesa 1649-WCG	2181
27386 7590 01/18/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			EXAMINER WYROZEBSKI LEE, KATARZYNA I	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			01/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/796,231

Applicant(s)

HUSEMANN ET AL.

Examiner

Katarzyna Wyrozebski

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment to the advisory.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Katarzyna Wyrozebski
Primary Examiner
Art Unit: 1796

Attachment to the Advisory

The Advisory Action is issued in response to the applicants communication dated 1/11/2008. Since the applicants have not amended the claims, the request for consideration will be entered.

New matter rejection of record is hereby withdrawn, since the applicants finally provided the examiner for support in the specification for term "at least one" when referring to ammonium polyphosphate. The examiner also requests that the applicant do not imply what examiner knows or does not know. Applicant's statement "*...Does examiner really think that it would require undue experimentation for one of ordinary skill in the art to determine how to add two or more ammonium polyphosphates to the flame retardant component instead of one...*" is viewed as demeaning, especially since the rejection had nothing to do with mixing or undue experimentation but merely with legalities of the utilized language. Next time the applicants are requested to provide specific support for the new limitation at the time the amendment is being made, which would avoid examiner's having to look all over the specification and in turn avoiding new matter rejections, in case if examiner is unable to find support.

In their response dated 1/11/2008 the applicants have not amended the claims. Therefore all rejections of record as stated in final office action dated 10/11/2007 are incorporated here by reference. Applicant's arguments are addressed below:

a) There seems to be a disagreement between the meaning of term “consisting essentially of” and comprising.

While it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. flame retardants, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03.

Term “consisting essentially of” would exclude components such as crosslinking agents, which upon addition to the composition would chemically alter the properties of the composition. Crosslinked polymers have different properties. However adding additional flame retardants to the composition, which is intended to be flame retardant is not viewed as additive that would materially alter the properties of the composition. Resulting article would still have flame retardant properties.

The flame retardants of PARSON not only would provide flame retardant composition, but also a composition that would retain its adhesive properties. In the event that the applicants will continue to argue examiner’s position, such position is supported by the MPEP citation above, and in addition, the prior art of PARSON teaches that one or more non-halogenated flame retardants can be utilized. Statement "one or more" enables use of only one flame retardant. These flame retardants are referred to as P/N retardants or those containing phosphorus and nitrogen.

In addition applicant's claims is viewed as open since when referring to the entire composition the applicants utilize term "comprising", thereby allowing all the components that materially do not affect properties of the composition.

The applicant further argues that PARSON does not disclose ammonium polyphosphate flame retardants utilized in acrylic adhesive.

Term "adhesive" appears on all claims of PARSONS, hence PARSONS teaches adhesive.

Term "acrylic" is listed in col. 4 and claim 1 of PARSON, hence PARSONS teaches acrylic adhesive. In addition acrylic polymer is viewed as one of the components of the composition.

Claim 5 of PARSON teaches that flame retardant is selected from group consisting of nitrogen containing oligomer and ammonium polyphosphate. Per claim 5, one flame retardant can be utilized or both.

Presence of Tackifying agent is not required but it is also not excluded. Adhesives C and D (both acrylic) in example 23 are tackified with rosin derivative. Tackifiers are further enabled by claim 3 of PARSON. Hence Parson teaches tackifying resins.

In view of the above discussion PARSON does anticipate claims of the present invention as indicated in final office action dated 10/11/2007.

Applicants indicated that the invention at hand teaches pressure sensitive adhesive – please see claims of PARSONS with that particular limitation as well.

b) Applicants argued the prior art of SAKURAI, for not teachings pressure sensitive adhesive.

It is examiner's position that adhesives of SAKURAI can also be pressure sensitive adhesive, since in order to bond two surfaces together as it is done in SAKURAI the two surfaces have to be pressed together, especially in view of elasticity provided by the addition of rubber component. Whether or not adhesive is permanent or temporary that is another issue not disclosed in the instant claims. The applicants have not shown that the adhesive of SAKURAI cannot perform as pressure sensitive adhesive.

Additional support of examiner's position in obviousness rejection as applied in office action is that term "adhesive" encompasses both pressure sensitive adhesive and non pressure sensitive adhesive.

c) With respect to the rejection of PARSON or SAKURAI in view of NISHIMURA, the applicants indicated that the prior art of NISHIMURA will not overcome deficiencies of PARSONS or SAKURAI.

It is examiner's position that based on discussion above, PARSONS and SAKURAI have no deficiencies at least with respect to the independent claims. The prior art of NISHIMURA was utilized to provide for limitations of dependent claims, which include additional acrylic based monomers suitable for use in adhesives. The applicants have not addressed the grounds of rejection as stated in the office actions of record.

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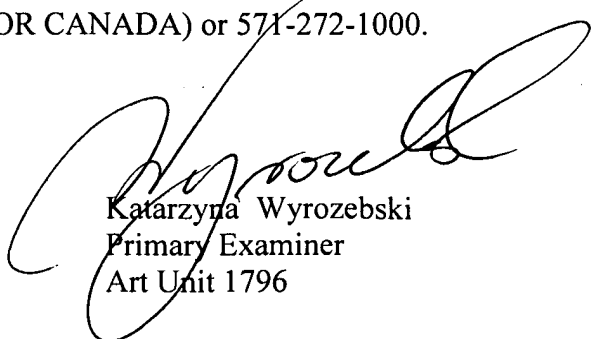
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In view of the above discussion per applicants request, claims have been re-consider but are not found allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Katarzyna Wyrozebski
Primary Examiner
Art Unit 1796

January 17, 2008